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OFFICE OF PETITIONS

In re Application of :
Ingram et al. :
Application No. 09/620,060 : DECISION ON APPLICATION
Filed: July 21, 2000 : FOR
Atty Docket No. 49950-59911CON: PATENT TERM ADJUSTMENT

This is a decision on the "PETITION FOR REVIEW OF A PATENT TERM EXTENSION PURSUANT TO 37 C.F.R. §§ 1.181 AND 1.704(c)(8)" filed November 9, 2006. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from zero (0) days to one thousand sixty-five (1065) days or at least eight hundred twenty-three (823) days.

The application for patent term adjustment is **GRANTED to the extent indicated herein.**

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is two hundred eighteen (218) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On August 9, 2006, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 0 days. On November 9, 2006, applicants timely submitted an application for patent term adjustment (with required fee)¹. Applicants do not dispute the period of

¹ PALM records indicate that the Issue Fee payment was also received on November 9, 2006.

reduction of 292 days for applicant delay. Rather, applicants argue that the period of adjustment for examination delay should be 1357 days or 1115 days. As such, the patent term adjustment would be 1065 (1357 - 292) or 823 (1,115 - 292) days.

Specifically, applicants first assert entitlement to a period of adjustment, pursuant to 37 C.F.R. § 1.702(a)(1)², for the Office's failure to respond to a reply under 35 U.S.C. §132 not later than four months after the date on which the reply was filed. Applicants calculate this period as 1357 days, from November 22, 2002 (the date that is four months after their filing of a terminal disclaimer on July 22, 2002) to August 9, 2006.

Alternatively, applicants assert entitlement to a period of adjustment, pursuant to 37 C.F.R. § 1.702(b), for the Office's failure to issue the patent within three years of the actual filing date. Applicants calculate this period as at least 1,115 days, from July 21, 2003 to August 9, 2006, the date of mailing of the Notice of Allowance.

(It is unclear why in this petition applicants reference § 1.704(c)(8) as this is a section pertaining to reducing the patent term adjustment for Applicant delay. Further, no correction of the PTA is required with respect to § 1.704(c)(8)).

Applicants state that the patent issuing from the application is not subject to a terminal disclaimer.

As for applicants' request for at least 1115 days of patent term adjustment on the basis of the Office's failure to issue the patent within 3 years of the filing date, a decision is being held in abeyance until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b).

Patentees are given TWO (2) MONTHS from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the

² Applicants should have cited 37 C.F.R. § 1.702(a)(2) for this delay.

request. Patentees may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

As to applicants' request for 1357 days of patent term adjustment on the basis of the Office's failure to take action within four months, applicants are correct that correction is required. The Office mailed an Office action under section 132 on August 15, 2002, within four months, of applicants' reply filed June 24, 2002. However, the Notice was not mailed to the correspondence address of record (but to an attorney not of record). The record supports a conclusion that this was due to an error on the part of the Office in mailing the Office action to applicants. Accordingly, a corrected Notice of Allowance was mailed on August 9, 2006.

Thus, the Office's delay should be calculating using the August 9, 2006 date. However, the period of delay is 1,385 days, not 1,357 days. Applicants' response was received on June 24, 2002. Thus, the period of adjustment is 1,385 days, the number of days in the period beginning on the day after the date that is four months after the date a reply under § 1.111 was filed, October 25, 2002, and ending on the date of mailing of a Notice of Allowance, August 9, 2006.

However, a review of the record reveals a further basis for reduction of the patent term adjustment, pursuant to 37 CFR 1.704(c)(4). No response to the Notice of Allowance mailed August 15, 2002 was considered timely filed by the Office and the application became abandoned. On December 26, 2002, the Office mailed a Notice of Abandonment. However, the record confirms that the Notice of Abandonment (as was the Notice of Allowance) was mailed to an improper address.

Petitioner is advised that if a petition to withdraw a holding of abandonment is not filed within two months from the mailing date of the notice of abandonment, any patent term adjustment will be reduced under the provisions of 37 CFR 1.704(c)(4). If applicant does not receive the notice of abandonment, any patent term adjustment may be reduced under the provisions of 37 CFR 1.704(a) by a period equal to the period of time during which the applicant "failed to engage in reasonable efforts to

conclude prosecution" (processing or examination) of the application, in which case any period of adjustment shall be reduced by the number of days, if any, beginning on the day after the date that is twelve months from the date of applicant's filing or submission of correspondence with the USPTO for which further action by the USPTO can reasonably be expected and ending on the filing date of a grantable petition to withdraw the holding of abandonment. *Untimely Filing of Petitions under 37 CFR 1.181(a) to Withdraw Holdings of Abandonment*, 1283 OG 147 (June 22, 2004).

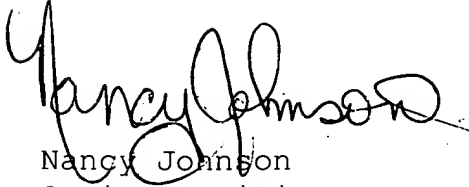
In this instance, on July 22, 2002, applicants filed a terminal disclaimer for which applicants state they expected further action (i.e., to receive a Notice of Allowance in due course). The Notice of Abandonment was not mailed to applicants at the proper correspondence address. Accordingly, it is being treated as never received by applicants. Applicants filed multiple status inquiries and changes of correspondence address. However, applicants never filed a petition to withdraw the holding of abandonment. The Office withdrew the abandonment on December 13, 2005. Accordingly, a period of reduction of 875 days for the period beginning on July 23, 2003, the day after the date twelve months from the date of filing of the terminal disclaimer, to December 13, 2005.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the notice of allowance is two hundred eighteen (218) days.

The \$200.00 fee set forth in 37 CFR 1.18(e) has been charged to petitioner's Deposit Account, as authorized. No additional fees are required.

The application is being forwarded to the Office of Patent Publication so that a patent can be issued. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

A handwritten signature in black ink, appearing to read "Nancy Johnson". The signature is fluid and cursive, with the first name "Nancy" being more prominent than the last name "Johnson".

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of Revised PAIR Screen

Day : Saturday
Date: 1/20/2007

PALM INTRANET

Time: 16:09:51

PTA Calculations for Application: 09/620060

Application Filing Date:	07/21/2000	PTO Delay (PTO):	0
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	292
Post-Issue Petitions:	0	Total PTA (days):	218
PTO Delay Adjustment:	510		

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EXPLANATION OF PTA CALCULATION

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